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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,659	02/21/2002	Suresh K. Marisetty	42390P2319RC	4488

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EXAMINER

AUVE, GLENN ALLEN

ART UNIT PAPER NUMBER

2181

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,659

Applicant(s)

MARISETTY, SURESH K.

Examiner

Glenn A. Auve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 51-105 have been renumbered 36-90. Since the claims from the parent reissue case are not pending in the continuation, the claim number should start with the next number after those in the original patent.

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,590,342 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

While applicant has generally referred to "excess limitations" there is no indication as to what those excess limitations are. In identifying the error it is sufficient to identify a single word,

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phrase, or expression in the specification or an original claim, and how it renders to original patent to be wholly or partly inoperative or invalid. The declaration must specifically identify an error. See MPEP § 1414.

4. Claims 36-90 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. Applicant's statement filed on July 3, 2001, in the parent case (09/224,620) that the original patent is lost is believed to also apply in this case. However, if applicant has located the original patent it must be surrendered prior to allowance of the reissue applications.

6. Claims 36-90 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As has also been previously argued in the parent case, the newly presented reissue claims in this application omit the “virtual device driver” limitation which applicant argued in the parent patent made the claims allowable. The Federal Circuit in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) addressed a similar situation in which the limitation that was added during the prosecution of the original patent to make the claims allowable was omitted in the new reissue claims but those reissue claims also contained further limitations which Pannu argued narrowed the scope of the claims in a way related to what was surrendered. The court concluded that on reissue, Pannu was estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections. The court also pointed to their decision in *Anderson v Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345,1349, 48 USPQ2d 1631,1634 (Fed. Cir. 1998).

Taking claim 36 as an example, applicant has not only removed the “virtual device driver” limitation, but rather the “device driver” limitation itself is gone. Instead of having power management by the “virtual device driver”, or as originally claimed in claim 11 of the patent the “device driver”, applicant has claimed instructions stored on a medium that perform steps of determining an amount of time a processor is in a first consumption state which comprises a period of time in which the processor clock is stopped and reducing voltage to the processor in response to the amount of time that processor is in the first state. So, in this aspect germane to the prior art rejection applicant has certainly broadened the claim beyond not only the “virtual device driver” limitation which was argued as the reason why the claim was allowable over the prior art, but has also broadened beyond the originally filed “device driver” for controlling the power management. Examining this situation in light of the court's decision in *Pannu*, applicant has broadened the claim with respect to the very aspect that made the claims allowable over the prior art, i.e. the virtual device driver controlling power management, while narrowing the

claim in an aspect that is not material to the prior art rejection, i.e. the addition of the processor clock being stopped limitation. Therefore, the claim is not narrowed in any material respect compared with the broadening. As the court held in *Pannu*, applicant is estopped from attempting to recapture the precise limitation added to overcome the prior art rejection. The fact that applicant may have had other limitations that he could have added to overcome the prior art rejection does not bar a recapture rejection.

With respect to the other independent reissue claims, they also eliminate the same virtual device driver limitation. The dependent reissue claims also fail to include the virtual device driver limitations and thus are also rejected for recapture as it applies to the claims on which they depend.

It is also noted that the specification itself states that “[t]he present invention provides for power management in a computer system using virtual device drivers (VxDs).” (col. 4, lines 65+) The specification further goes on to describe only how the invention is accomplished using the virtual device drivers for controlling power management aspects of the system. So, the specification itself would seem to lend support to the idea that what applicant invented and considered to be his invention was the use of virtual device drivers to control power management.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show clock stopping and reducing power consumption. But they do not appear to time the amount of time the processor's clock is stopped and somehow further reducing power after the clock has been stopped for a certain amount of time.


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8. The references cited in the IDS filed 2/21/2002 have been entered on the PTO-892 form being provided with this action since the 1449 and 892 cited in the IDS are from the parent case.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Wong can be reached on (703) 305-3477. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Glenn A. Auve
Primary Examiner
Art Unit 2181

gaa
August 23, 2002